101 - 790.⁰⁰
2 - 738⁰⁰
3 - 1870.⁰⁰

FISH ● RICHARDSON P.C.

Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

October 24, 1997

Attorney Docket No.: **09005/012001**

BOX PATENT APPLICATION
Assistant Commissioner for Patents
Washington, DC 20231

BOSTON

HOUSTON

NEW YORK

SOUTHERN CALIFORNIA

SILICON VALLEY

TWIN CITIES

WASHINGTON, DC

Presented for filing is a new patent appliction claiming priority from a provisional patent application of:

Applicant:	TIMOTHY J. WILKINSON, SCOTT B. GUTHERY, KSHEERABDHI KRISHNA AND MICHAEL A. MONTGOMERY
Title:	USING A HIGH LEVEL PROGRAMMING LANGUAGE WITH A MICROCONTROLLER

Enclosed are the following papers, including all those required for a filing date under 37 CFR §1.53(b):

Pages of Specification	39
Pages of Claims	19
Pages of Abstract	1
Signed Declaration	[To Be Filed At A Later Date]
Sheets of Drawing	23
Appendix A	7
Appendix B	2
Appendix C	3
Appendix D	4
Appendix E	2
Appendix F	2

"EXPRESS MAIL" Mailing Label Number <u>EI267842785US</u>

Date of Deposit <u>**October 24, 1997**</u>

I hereby certify under 37 CFR 1.10 that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office To Addressee" with sufficient postage on the date indicated above and is addressed to the Assistant Commissioner for Patents, Washington, DC. 20231.

<u>Tina Grimstead-Campbell</u>

Appendix G   6
Appendix H   1
Appendix I   3

Under 35 USC §119(e)(1), this application claims the benefit of prior U.S.
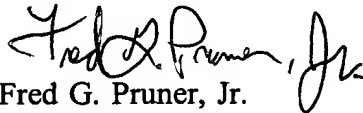provisional application 60/029,057, filed October 25, 1996.

Basic filing fee   790.00
Total claims in excess of 20 times $22.00   1870.00
Independent claims in excess of 3 times $82.00   738.00
Multiple dependent claims   0.00
Total filing fee: $ 3398.00

A check for the filing fee is enclosed. Please charge any other required fees, or
apply any credits, to Deposit Account No. 06-1050, referencing the Attorney Docket
number shown above.

If this application is found to be INCOMPLETE, or if it appears that a telephone
conference would helpfully advance prosecution, please telephone the undersigned at
713/629-5070.

Kindly acknowledge receipt of this application by returning the enclosed postcard.

Respectively submitted,

Fred G. Pruner, Jr.
Reg. No. 40,779

FGP/jlm
Enclosures

63591.H11

SN 08/957,512

As properly stated by the two examiners who have been consulted in the disposition of this application, the invention is drawn to the combination between a known operating system (JAVA) and a known platform (Smart Card). The question lies in where the case would be best examined. Both examiners have alleged that there is nothing novel about the individual aspects of the invention.

In reviewing the claims, it appears that the claim limitations drawn to the programming application (see for example claims 31-51, 68-94, 100-105) would present much more difficulty to an examiner in class 235, than would the broad recitation of IC cards with associated processors and memories to an examiner in class 395.

The examiner who refused the case in class 395 has indicated that an examiner from that class would have to learn about smart cards to work on this case. A quick search on APS reveals 122 patents include smart cards and are in class 395. A large number of these patents have issued in class 395. The examiner who refused the application even issued a patent (5,752,040) which deals with changing a program loaded in the memory of a smart card. Doing a similar APS with "JAVA" and class 235 reveals only three patents. All three patents broadly refer to the use of JAVA and fail to recite the specifics as set forth in the claims.

As evidenced by this, it would appear that an examiner in class 395 would be best suited to examine this application. However, f it is finally determined that the case should be examined in class 235, it is respectfully requested that an examiner in class 395 provide prior art that would describe the "know features" of JAVA set forth in the claims.

Donald Hajec
Supervisory Patent Examiner
Technology Center 2800